

PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: James Kevin Gillie
Serial No: 10/803,360 Group Art Unit: 1711
Filed: March 18, 2004 Examiner: Thao Tran
Att. Docket No.: A1019/20354 Confirmation No.: 5836
For: URETHANE BASED COATING APPLIED IN-LINE FOR IMPROVED INK
ADHESION

REPLY BRIEF

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is responsive to the Examiner's Answer mailed from the United States Patent and Trademark Office on February 26, 2007, and is being filed to point out that a number of Appellant's positions supporting the patentability of the claims in this application were not addressed in the Examiner's Answer.

Appellant pointed out in the Appeal Brief that the primary reference (Kinoshita et al. U.S. Patent No. 5,824,394) requires that the inventive film includes a specified polyester film composition. In the Examiner's rejection suggesting that the polyester film in the Kinoshita et al. structure could be replaced by a polypropylene film, the Examiner did not address Appellant's position that such a replacement would destroy the inventive feature in the Kinoshita et al. patent.

Appellant pointed out in the Appeal Brief that although the secondary patent to Posey et al. disclosed the use of a base film that could be polyester or polypropylene, Posey et al. also demonstrated that these different base films did not perform in the same manner, and were not

even equivalent within the teachings of the Posey et al. patent. This position was not addressed by the Examiner.

Appellant also pointed out in the Appeal Brief that the invention disclosed in Posey et al. related to the use of specific co-polyester primer coatings, and that even with the use of the inventive coatings, the adhesive properties in conjunction with the polyester film were substantially different than the adhesive properties in conjunction with the polypropylene film. Although Appellant pointed out in detail the differences in performance in the discussion of Example 28 and Table II, beginning on page 10 of the Appeal Brief, the Examiner failed to address that position.

In the Examiner's "Response to Argument" beginning on page 5 of the Examiner's Answer, he addresses or attempts to address Appellant's argument that there is no suggestion to combine the references. First, Appellant re-affirms his position that there is no suggestion to combine the references in the manner suggested by the Examiner because such a combination would destroy the invention feature of the primary reference. In addition, the secondary reference does not teach the equivalence between a polyester film and a polypropylene film for any purpose, let alone for use in the film construction disclosed in the primary reference.

Very significantly, although the Examiner attempts to argue that there is a motivation for combining Kinoshita and Posey, et al. in the manner set forth in the Final Rejection, the Examiner did not address Appellant's positions 2 through 4 set forth on page 8 of the Appeal Brief. Moreover, as is clearly pointed out in the Appeal Brief, there is absolutely no motivation for combining Kinoshita and Posey et al. in the manner suggested by the Examiner, primarily

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because Kinoshita et al. makes it abundantly clear that the inventive film described and claimed in that patent needs to be a polyester film.

CONCLUSIONS

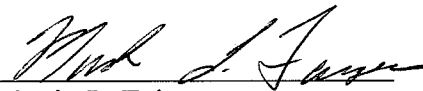
For all of the above reasons, including the reasons presented in detail in the original Appeal Brief, Appellant submits that the rejection advanced by the Examiner should be reversed.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

April 26, 2007

Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.

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